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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/764,884

01/26/2004

Hidehiko Asai

CANO:026A

9693

7590

12/02/2004

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EXAMINER

LEE, SUSAN SHUK YIN

ART UNIT

PAPER NUMBER

2852

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,884	<b>Applicant(s)</b> ASAI ET AL.	
	<b>Examiner</b> Susan S. Lee	<b>Art Unit</b> 2852	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/7/04 & 1/26/04.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,12-19,22 and 24-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 28, 30, 31, 33, 34 is/are allowed.  
 6) ☒ Claim(s) 1,3-9,12-19,22,24-27 and 29 is/are rejected.  
 7) ☒ Claim(s) 32 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☒ Certified copies of the priority documents have been received in Application No. 09/859,900.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because "said", line 5 should be avoided. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

Claim 32 is objected to because of the following informalities:

As to claim 32, line 2, "said operation panel" lacks antecedent basis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 12-19, 22, 24-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino (5,289,236) in view Hirooka (Japan, 11-48580).

Yoshino discloses an image forming apparatus, copying machine 1 with a plurality of feeders or paper supply cassettes 7, 31a, 31b, 31c for feeding sheets; a memory such as non-volatile memory 72 that stored data as priorities relative to paper sizes; and a selection control circuit 70a or selection means that is incorporated in the main CPU 70. If desired paper is exhausted during the successive paper feeding, a paper supply cassette storing higher priority size papers is selected from the paper supply cassette 7, 31a, 31b, and 31 according to the priority data of the changing sequence of paper sizes set in the non-volatile memory 72. An operator can set copying conditions such as the number of desired copies, copying magnification, paper size, etc through a control panel 40. Note column 5, line 37 – column 7, line 19. CPU 70 may select a paper supply cassette storing papers in the size that is determined to be proper by CPU 70 from the original document size sensed by an original document size detector. Note column 8, lines 13-20. It is well known in the art that CPU 70 has a control program that has codes that are associated with the control of the apparatus as discussed above. It is also well known in the art that the sheet sizes of Yoshino are stored in the memory 72 since the stored data is relative to the paper sizes.

Yoshino differs from the instant invention by not disclosing sheet types other than sheet sizes.

Hirooka discloses a printer in which a sheet having attributes such as paper feeding port, name of the sheet, sheet size and sheet type can be designated by a user

using an operating panel. The designation can also be based on a print data. When a sheet having the designated attributes or a corresponding paper feeding port is not present at the time of sheet selection, an error is notified and designated attributes are checked with a specified priority and a process for selecting an alternative sheet is carried out. Note abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Yoshino with that of Hirooka so that alternative sheets of different types as well as sizes can be chosen in case the selected sheet is not available for printing. This saves the user time when a print job has ran out of selected sheets to be used in the print job.

***Allowable Subject Matter***


Claims 28, and 30-34 are allowed over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan S. Lee whose telephone number is 571-272-2137. The examiner can normally be reached on Mon. - Fri., 10:30-8:00, Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Art Grimley can be reached on 571-272-2136 or 571-272-2800 (Ext. 52). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2852

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susan S. Lee  
Primary Examiner  
Art Unit 2852

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